

12/03/04

DAC/ #  
(I) IAW

"Express Mail" mailing label number: EV 327107202 US  
Date of deposit: December 2, 2004

Our Case No. 6270/66  
(PML Case No. 300066)



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Benedict T. Huber, et. al. )  
Serial No. 09/931,145 ) Examiner: Mary C. Baran  
Filing Date: August 15, 2001 ) Group Art Unit No. 2857  
Title: EXPANDABLE INTELLIGENT )  
ELECTRONIC DEVICE )

12/06/2004 MWOLDGE2 00000014 09931145

03 FC:1455

200.00 OP

**REQUEST FOR RECONSIDERATION OF**  
**PATENT TERM ADJUSTMENT**  
**PURSUANT TO 37 C.F.R. § 1.705(b)**

Mail Stop Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

A notice of allowance was issued for the present application on October 6, 2004 indicating that the issue fee is due on January 6, 2004. The issue fee is being submitted for the present application in conjunction with this request for reconsideration of the patent term adjustment. The Patent Application Information Retrieval (PAIR) system and the notice of allowance both indicate a patent term adjustment that was calculated by the U.S. Patent office pursuant to 37 C.F.R. 1.701 of 475 days. A copy of Notice of Allowance for the present application is included herewith as Exhibit A.

Applicant's Attorney believes that the patent term adjustment should be 527 days. For the reasons stated herein, reconsideration of the patent term adjustment is respectfully requested

pursuant to 37 C.F.R. 1.705(b). Please charge the petition fee pursuant to 37 C.F.R. § 1.18(e) to Deposit Account No. 23-1925. Please charge any additional fee required or credit for any excess fee paid to Deposit Account No. 23-1925. A duplicate copy of this Petition is attached.

The patent term adjustment for the present application was calculated by the U.S. Patent and Trademark Office based on activities and associated dates detailed in the Patent Application Information Retrieval (PAIR) system Patent Term Adjustment History, attached as Exhibit B. Applicant's Attorney believe that errors and/or omissions in the calculation and/or the PAIR system Patent Term Adjustment History may have resulted in an incorrect patent term adjustment for the present application as described in detail below. The present application is not subject to a terminal disclaimer. In addition, there were no circumstances during the prosecution of the application resulting in the notice of allowance that constitute a failure of the Applicant to engage in reasonable efforts to conclude processing or examination of the present application as set forth in 37 C.F.R. §1.704.

**Period of adjustment pursuant to 37 C.F.R. § 1.703**

Period of adjustment pursuant to 37 C.F.R. § 1.703(b)

The period of adjustment pursuant to 37 C.F.R. § 1.703(b) is the number of days in the period beginning on the day ("the 3 year date") after the date that is three years after the date on which the application was filed pursuant to 35 U.S.C. § 111(a) or fulfilled the requirements pursuant to 35 U.S.C. § 371.

The present application was filed on August 15, 2001 as evidenced by the filing receipt attached as Exhibit C. The 3 year date specified in 37 C.F.R. § 1.703(b) is August 15, 2004. The period of adjustment pursuant to 37 C.F.R. § 1.703(b) is the number of days in the period beginning on August 15, 2004 ("the 3 year date") until the patent issues. Pursuant to 37 C.F.R. § 1.703(b) the

Applicant is entitled to a period of adjustment due to a delay in examination of this Application by U.S. Patent and Trademark office that is equal to the number of days between August 15, 2004 and the actual issuance date of the patent.

The delay for this Application by the U.S. Patent and Trademark office is identified in 37 C.F.R. § 1.703(a)(1). The period of adjustment pursuant to 37 C.F.R. § 1.703(a)(1) is the number of days in the period beginning on the day ("the 14 month date") after that date that is fourteen months after the date on which the application was filed pursuant to 35 U.S.C. § 111(a), or fulfilled the requirements pursuant to 35 U.S.C. § 371, and ending on the date of mailing of either an action pursuant to 35 U.S.C. § 132 or a notice of allowance pursuant to 35 U.S.C. § 151, whichever comes first. The present application was filed on August 15, 2001. The 14 month date specified in 37 C.F.R. § 1.703(a) is October 15, 2002. According to the PAIR system Patent Term Adjustment History, attached as Exhibit B, the first action on the merits by the U.S. Patent and Trademark office in the present application was actually mailed on February 2, 2004. Thus, the difference between the 14 month date and the date of mailing of the first action on merits is a delay of 475 days.

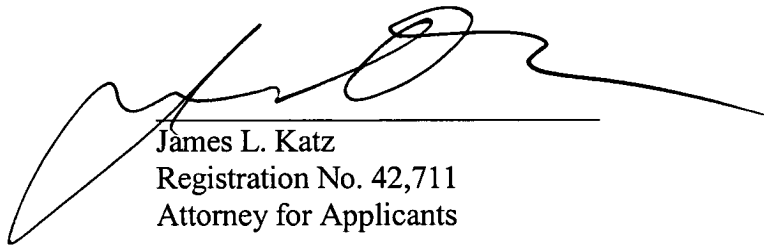
The mailing date of the Notice of Allowance was October 6, 2004 as evidenced by the copy of the Notice of Allowance included herewith as Exhibit A. On the date of this mailing, the present application already exceeded the 3 year date by 52 days. Applicant's Attorney expects that additional delay can reasonably be expected prior to a patent issuing for the present application. Applicant's Attorney therefore requests re-computation of the period of adjustment pursuant to 37 C.F.R. § 1.703 upon identification of the date of issue of the patent of the present application to reflect this delay. With this request, Applicant's Attorney further reserves the right to request reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d) if the term of the issued patent is believed to be extended or adjusted incorrectly.

**Total patent term adjustment**

For the present application, the total patent term adjustment pursuant to 37 C.F.R. § 1.703(f) is the period of adjustment pursuant to 37 C.F.R. § 1.703 reduced by any delays pursuant to 37 C.F.R. § 1.704. Thus, according to our calculations, we believe that the patent term adjustment should be  $(475+52)$  days = 527 days, instead of 475 days indicated on the Notice of Allowance attached as Exhibit A.

It is respectfully asserted that the patent term adjustment determined by the U.S. Patent and Trademark Office for the present application may not be correct. Accordingly, Applicant's Attorney respectfully requests the U.S. Patent and Trademark office to reconsider, and make revisions to the PAIR system Patent Term Adjustment History in view of the previous remarks. In addition, it is respectfully requested that the patent term adjustment be re-calculated by the U.S. Patent and Trademark Office in view of the above remarks. Office personnel are invited to contact the undersigned attorney for the Applicant's via telephone if such communication would be beneficial in fulfilling this request.

Respectfully submitted,



James L. Katz  
Registration No. 42,711  
Attorney for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

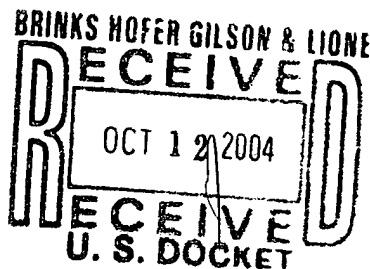


# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

## NOTICE OF ALLOWANCE AND FEE(S) DUE

757 7590 10/06/2004  
BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610



EXAMINER	
BARAN, MARY C	
ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 10/06/2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,145	08/15/2001	Benedikt T. Huber	6270/66	3165

TITLE OF INVENTION: EXPANDABLE INTELLIGENT ELECTRONIC DEVICE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1370	\$300	\$1670	01/06/2005

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

### HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

# **PART B - FEE(S) TRANSMITTAL**

Complete and send this form, together with applicable fee(s), to: **Mail**

**Mail Stop ISSUE FEE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
or Fax (703) 746-4000**

**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

757 7590 10/06/2004

**BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610**

## **Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (703) 746-4000, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,145	08/15/2001	Benedikt T. Huber	6270/66	3165

TITLE OF INVENTION: EXPANDABLE INTELLIGENT ELECTRONIC DEVICE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1370	\$300	\$1670	01/06/2005

EXAMINER	ART UNIT	CLASS-SUBCLASS
BARAN, MARY C	2857	702-062000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
- ☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively,
- (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 \_\_\_\_\_

2 \_\_\_\_\_

3 \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are enclosed:

- ☐ Issue Fee
- ☐ Publication Fee (No small entity discount permitted)
- ☐ Advance Order - # of Copies \_\_\_\_\_

4b. Payment of Fee(s):

- ☐ A check in the amount of the fee(s) is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above. NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_

Date \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Registration No. \_\_\_\_\_

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,145	08/15/2001	Benedikt T. Huber	6270/66	3165
757	7590	10/06/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			BARAN, MARY C	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 10/06/2004

## Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 475 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 475 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,145	08/15/2001	Benedikt T. Huber	6270/66	3165
757	7590	10/06/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			BARAN, MARY C	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 10/06/2004

## Notice of Fee Increase on October 1, 2004

If a reply to a "Notice of Allowance and Fee(s) Due" is filed in the Office on or after October 1, 2004, then the amount due will be higher than that set forth in the "Notice of Allowance and Fee(s) Due" because some fees will increase effective October 1, 2004. See Revision of Patent Fees for Fiscal Year 2005; Final Rule, 69 Fed. Reg. 52604, 52606 (May 10, 2004).

The current fee schedule is accessible from WEB site (<http://www.uspto.gov/main/howtofees.htm>).

If the fee paid is the amount shown on the "Notice of Allowance and Fee(s) Due" but not the correct amount in view of the fee increase, a "Notice of Pay Balance of Issue Fee" will be mailed to applicant. In order to avoid processing delays associated with mailing of a "Notice of Pay Balance of Issue Fee," if the response to the Notice of Allowance is to be filed on or after October 1, 2004 (or mailed with a certificate of mailing on or after October 1, 2004), the issue fee paid should be the fee that is required at the time the fee is paid. See Manual of Patent Examining Procedure (MPEP), Section 1306 (Eighth Edition, Rev. 2, May 2004). If the issue fee was previously paid, and the response to the "Notice of Allowance and Fee(s) Due" includes a request to apply a previously-paid issue fee to the issue fee now due, then the difference between the issue fee amount at the time the response is filed and the previously-paid issue fee should be paid. See MPEP Section 1308.01.

Effective October 1, 2004, 37 CFR 1.18 is amended by revising paragraphs (a) through (c) to read as set forth below.

### Section 1.18 Patent post allowance (including issue) fees.

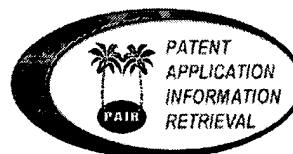
- (a) Issue fee for issuing each original or reissue patent, except a design or plant patent:
- By a small entity (Sec. 1.27(a))..... \$685.00
  - By other than a small entity..... \$1,370.00
- (b) Issue fee for issuing a design patent:
- By a small entity (Sec. 1.27(a))..... \$245.00
  - By other than a small entity..... \$490.00
- (c) Issue fee for issuing a plant patent:
- By a small entity (Sec. 1.27(a))..... \$330.00
  - By other than a small entity..... \$660.00

Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.





## United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)
**PATENT APPLICATION INFORMATION RETRIEVAL****Patent Term Adjustment (PTA) for publication number: 09/931,145**

			Days
Filing or 371(c) Date:	08-15-2001	USPTO Delay (PTO):	475
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	0
Post-Issue Petitions (days):	+0	Total PTA:	475
USPTO Adjustment (days):	+0	Explanation of Calculations	

## Search Options

Continuity Data
Image File Wrapper
File History
Published Documents

**Patent Term Adjustment History**

Date	Contents Description	PTO (days)	APPL (days)
10-06-2004	Mail Notice of Allowance		
10-06-2004	Mail Examiner's Amendment		
09-17-2004	Examiner Interview Summary Record (PTOL - 413)		
10-01-2004	Examiner's Amendment Communication		
09-23-2004	Issue Revision Completed		
09-20-2004	Notice of Allowance Data Verification Completed		
09-20-2004	Notice of Allowability		
09-13-2004	Date Forwarded to Examiner		
08-24-2004	Amendment after Final Rejection		
09-13-2004	Date Forwarded to Examiner		
08-24-2004	Amendment after Final Rejection		
08-24-2004	Workflow incoming amendment IFW		
07-08-2004	Mail Final Rejection (PTOL - 326)		
06-24-2004	Final Rejection		
04-22-2004	Date Forwarded to Examiner		
04-12-2004	Response after Non-Final Action		
04-12-2004	Workflow incoming amendment IFW		
02-27-2004	Information Disclosure Statement (IDS) Filed		
02-02-2004	Mail Non-Final Rejection	475	
12-10-2001	Reference capture on IDS	↑	
12-10-2001	Information Disclosure Statement (IDS) Filed	↑	
01-26-2004	Non-Final Rejection	↑	
01-09-2004	IFW TSS Processing by Tech Center Complete	↑	
01-09-2004	Reference capture on IDS	↑	

08-25-2003	Information Disclosure Statement (IDS) Filed	↑	
03-18-2002	Information Disclosure Statement (IDS) Filed	↑	
12-31-2002	Preliminary Amendment	↑	
12-17-2001	Preliminary Amendment	↑	
05-27-2003	Information Disclosure Statement (IDS) Filed	↑	
11-21-2002	Case Docketed to Examiner in GAU	↑	
04-01-2002	Information Disclosure Statement (IDS) Filed	↑	
12-03-2001	Information Disclosure Statement (IDS) Filed	↑	
11-20-2001	Case Docketed to Examiner in GAU	↑	
09-19-2001	Application Dispatched from OIPE	↑	
09-18-2001	Correspondence Address Change	↑	
08-23-2001	IFW Scan & PACR Auto Security Review	↑	
08-15-2001	Initial Exam Team nn	↑	

**Director of the United States  
Patent & Trademark Office  
Washington, D.C. 20231**

Case No. 0270/00  
Applicant Huber et al.

Dir Applicant: Benedikt T. Huber et al.

Serial No.

Wi Client/Matter: 6270/66

Plt Exp. Mail EL 500981488 US

Items Mailed: Appln. Transmittal (C.I.P.) (2pp. Filed in Dup.);  
Patent Application (60 pp. Specification and 20 pp. of Drawings); Check  
for \$1626; Assignment Recordation Cover Sheet (1p. 1p.); Executed  
Assignment; Declaration, and Power Attorney; Check for \$40; and PTO  
Reply Postcard

jc971 U.S. PTO  
09/931145  
08/15/01

BRINKS HOFER GILSON & LIONE

By: Vincent J. Gnoffo, Reg. No. 44, 714

Date of Mailing: August 15, 2001

E